

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on August 5, 2003, and the references cited therewith.

Claims 1, 25, 49, and 73 are amended, no claims are cancelled, and no claims are added; as a result, claims 1-96 remain pending in this application.

§103 Rejection of the Claims

Claims 1-96 were rejected under 35 USC § 103(a) as being unpatentable over Iwai et al. (Iwai), US 5,175,681, 29 December 1992 in light of Immerman et al. (Immerman), 6,574,617, 3 June 2003.

Iwai describes a computerized system for managing industrial property rights in various countries, and includes rule data for the various countries as well as a database for storing information related to each application. Iwai fails to consider doing so in the context of the Internet or another public network, or incorporation of a security module to restrict public access to the rules, database, and other elements of the system. The Office Action argues that the USPTO does not make such information public, but this does not bear upon what is disclosed within Iwai, which is designed as a closed system not needing or considering such security measures.

Immerman describes a system in which an online services module for Lotus can be configured to auto-download applications from the Lotus server to a client using Internet Notes (iNotes), and to control security, object data storage, replication, mail, and workflow functions on the iNotes client. Although Immerman does discuss a security policy applied to applications and documents, it fails to teach restricting task and matter data to selected system users as was recited in the pending claims.

Although neither of the cited references teaches a security module operable to restrict task and matter data to selected system users, applicant has elected to amend the present claims to further clarify distinctions between the pending claims of the present invention and the cited references. Claim 1, for example, now recites "a security module, the security module operable to restrict Internet access to patent application task and matter data management to selected system users", bringing Internet connectivity out of the preamble and into the elements of the

claims, giving them greater distinction from references such as Iwai. Also, as the security module now more explicitly recites restricting access to patent application task and matter data, the security module is further distinguished from references such as Immerman, which teaches security for documents, forms, and folders in the unique context of an iNotes client requesting data from a Lotus server running the DOLS service.

Also, motivation to combine the two cited references has not been shown to be present in the references themselves, nor has a suggestion of success or desirability of such combination. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

In conclusion, the pending claims are believed to be allowable over the cited art, because the cited references fail to teach a security module operable to restrict Internet access to patent application task and matter data management to selected system users, and for the other reasons stated above. Applicant has amended the claims to more clearly distinguish the present invention from the references cited, in hopes of clarifying the distinctions between the cited art and the pending claims thereby expediting prosecution of this matter.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 349-9581) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

Respectfully submitted,

STEVEN W. LUNDBERG

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 349-9581

Date Nov. 5 '03

By John M. Dahl

John M. Dahl
Reg. No. 44,639

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 5th day of November, 2003.

Dawn M. Foote

Name

Dawn M. Foote

Signature